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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/877,239 | 06/11/2001 | Frederick J. Murphy | 001223.00016 | 8643 |

32665 7590 11/09/2004

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| EXAMINER |
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ROGERS, SCOTT A

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| ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.



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#13

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Paper No. 15

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In re Application of
Frederick J. Murphy
Application No. 09/877,239
Filed: June 11, 2001

DECISION ON REQUEST TO
WITHDRAW FROM RECORD

For: **METHOD AND APPARATUS FOR
DELIVERY OF FACSIMILE DOCUMENTS
OVER A COMPUTER NETWORK**

This is a Requirement for Information to Applicant pursuant to 37 C.F.R. §1.105, as well as a decision on the Request for Withdrawal as attorney, and also a decision on the request for continued suspension filed June 23, 2004.

Applicant of this application is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Applicant has attempted to take action in the subject application including the filing of a revocation of power of attorney (paper No. 8) filed July 29, 2004. The subject application was filed as a divisional application wherein there is an assignment of record in the U.S. Patent and Trademark Office for parent application 08/555,911 which states that the inventor "...hereby confirm and ratify my prior sale, assignment and transfer to NetFax Incorporated...the full and exclusive right, title and interest in and to the invention which is the subject of United States Patent Application No. 08/555,911...and any and all Letters Patent which may be granted therefore in the United States and its territorial possessions and in any and all foreign countries, and in and to any and all divisions, reissues, continuations and extensions thereof."

Within the Request to Withdraw as attorney/agent of record filed August 13, 2004, it is alleged that the subject application is not in fact a divisional application of 08/555,911, but rather a continuation-in-part thereof.

Therefore, Applicant is required to explicitly set forth the subject matter which has been added to the invention disclosed in the parent application 08/555,911 to support Applicant's allegation that the instant application is a continuation-in-part as opposed to a divisional application. Specifically, Applicant must specify by reference to: the detailed description in the specification, if appropriate; the drawings, if appropriate; and the claims, if appropriate, specifically identifying the subject matter that has been added to the invention initially disclosed in the 08/555,911 application. Applicant must provide the aforementioned explicit information for at least one allegation of newly disclosed subject matter to support the alleged continuing status of this instant application.

The information is required to determine if the actions requested by the Applicant, i.e., the revocation of power of attorney of July 29, 2004, should have been granted by the Office.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

As indicated, a shortened statutory period of 2 months is set for reply to the 37 CFR §1.105 requirement. Failure to respond to this requirement will result in the vacating of the Revocation of Attorney request filed July 29, 2004.

With respect to the request to withdraw, a grantable request to withdraw as attorney/agent of record must:

- (1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
- (2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
- (3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
- (4) indicate the address to which future correspondence should be mailed.

The request to withdraw was filed as a "Conditional" request. The Office will not process "Conditional" communications. In addition, the request to withdraw fails to indicate the address to which future correspondence should be mailed. Thus, the petition to withdraw is **Denied**.

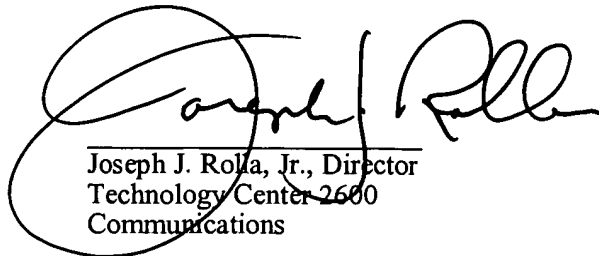
With respect to Applicant's request for continuation of suspension until September 1, 2004.

MPEP § 1.103 Suspension of action by the Office, states in part:

(a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

- (1) A showing of good and sufficient cause for suspension of action; and
- (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

Given that the requested time period for continuation of suspension has expired, Applicant's request is deemed **Moot**.



Joseph J. Rolla, Jr., Director
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Communications